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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/993,946 12/18/97 SILVESTRINI

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QM12/0317

EXAMINER

WILLSE, D

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

03/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/993,946

Applicant(s)
SILVESTRINI

Examiner
Dave Willse

Group Art Unit
3738



☒ Responsive to communication(s) filed on Nov 9, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) 18, 19, and 25 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 and 20-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 and 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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In the Information Disclosure Statement of May 22, 1998, the Swiss patent document was *not* considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) was not presented.

Applicant's election with traverse of Invention I in Paper No. 7 is acknowledged. The traversal is on the grounds that "the insert of claim 25 cannot be used in such materially different processes from those described in claims 1-17 and 20-24 as proposed by the Examiner" (page 2, lines 13-14, of paper no. 7). This is not found persuasive because the Applicant's remarks are based upon claim 25 *as amended* after the mailing of the restriction requirement (paper no. 5) and are thus not relevant to said restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 11, line 2, "aperture" is misspelled.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 14-17, and 20-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Peyman, US 5,964,748. Particular attention is directed to column 12, lines 34-40; column 13, lines 32-35; column 15, lines 58-66; and column 17, lines 28-31. Regarding claims 2 and 3: column 17, lines 36-40; column 12, lines 35-37; and Figures 41-45. Regarding claims 16, 17, 22, and 23: column 16, line 63, through column 17, line 5.

Claims 6, 8-11, 13, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman, US 5,964,748. Side legs as set forth in instant claims 6, 8, and 13 would have been obvious from column 13, lines 32-35, and column 15, lines 64-66, in order to accommodate the shape of the ocular material **430** (column 17, lines 28-31; Figure 42), with further motivation having been provided by Figures 27 and 36. Regarding claim 24, the tool **450** being arc-shaped would have been obvious in order to match the circular shape of the pocket **426** and/or a curved incision (column 15, lines 43-44).


Claims 4, 5, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman, US 5,964,748, in view of Mathis et al., US 5,846,256. To employ the clockwise and counter-clockwise dissectors and channel connectors taught in Mathis et al. would have been obvious in order to provide better matching of the circular intracorneal channel dimensions with

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those of the ring implant **430** of Peyman, with further motivation to use complementally shaped tools having been provided by column 17, lines 19-22, 28-31, 39-42, and 49-51, of Peyman.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The supervisory patent examiner is Mickey Yu, whose telephone number is (703) 308-2672. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
March 12, 2000


DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738